

Appeal Brief  
Appl. No.: 10/660,337  
Submitted on March 24, 2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

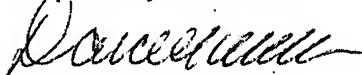
Appl. No.:	10/660,337	Confirmation No.: 5985
Applicant:	Ernest et al.	
Filed:	September 11, 2003	
TC/A.U.	2109	
Examiner:	Bryan P. Bui	
Docket No.:	AUS920030409US1	
Customer No.:	46129	
Title:	METHOD AND SYSTEM FOR MANAGING LOCALLY INITIATED ELECTRONIC MAIL ATTACHMENT DOCUMENTS	

Honorable Commissioner  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

**FEE TRANSMITTAL OF APPEALLANT'S BRIEF  
IN RESPONSE TO OFFICE ACTION UNDER**

Applicant files the attached Appeal Brief in support of the Notice of Appeal filed by Applicant on December 15, 2008 in the above-identified application. Please charge the fee of \$540.00 to Deposit Account No. 09-0447. Therefore the filing of the brief is considered timely filed.

Respectfully submitted,



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Appl. No. 10/660,337  
Appeal Brief  
Date: January 29, 2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**APPELLANT'S BRIEF  
IN RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 1.192**

This brief is filed in triplicate in support of the previously filed Notice of Appeal, which was filed December 15, 2008 which appealed from the decision of the examiner dated August 14, 2008, rejecting claims 1-4, 7-8, 10, and 12-27. The fee required under 37 C.F.R. § 1.17(c) for filing a brief in support of an appeal is provided in the Transmittal of Appeal Brief filed herewith.

**1. REAL PARTY IN INTEREST**

The real party in interest in this appeal is International Business Machines Corporation (IBM).

**2. RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

**3. STATUS OF CLAIMS**

Claims 1-4, 7-8, 10, and 12-27 are pending in this application; claims 1-4, 7-8, 10, and 12-27 have been appealed. Claim 12 has been canceled. No claims have been allowed.

**4. STATUS OF AMENDMENTS**

Applicant has filed an amendment after final to address examiner's rejections. The examiner did not enter the amendments.

## **5. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claim 1 describes a method for managing attachments documents to electronic mail messages by first determining whether a received electronic mail message at a destination location has a document attached to it (Fig. 4, step 48 and paragraph [0028]). When the electronic message does have an attached document there is a determination of whether the attachment was created at the location of the sender of the electronic message (Fig. 4, step 49 and paragraph [0028]). Next, when the determination is that the attachment did come from the sender location, the attached document is deleted from the electronic message (Fig. 7, step 76 and paragraph [0032]). After the deletion of the attached document, a link is created to the location of the original document at the destination location (Fig. 4, step 50 and paragraph [0028]). When there is a determination that the attachment document was originally created at the location of the sender of the electronic mail message, deleting the attachment document (Fig. 4, step 51 and paragraph [0028]). When an attachment is deleted, updating the received message to reflect the deleted attachment (Fig. 6, step 70 and paragraph [0031]). The last step determines if there are additional attached documents in the received electronic mail message (Fig. 6, step 72 and paragraph [0031]).

Claim 8 describes a method for managing attachments documents to electronic mail messages by first receiving an electronic mail message at a destination location (Fig. 7, step 73 and paragraph [0032]). Next there is a determination of whether a received electronic mail message at a destination location has a document attached to it (Fig. 7, step 74 and paragraph [0032]). When the determination is that the received electronic mail message does have the attachment document, the next step determines whether the attachment was locally created (Fig. 7, step 76 and paragraph [0032]). When the determination is that the attachment document was locally created, determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message (Fig. 7, step 78 and paragraph [0032]). When the determination is that the user does not want to modify the attachment document, the next step deletes the attachment document from the message

(Fig. 7, step 79 and paragraph [0032]). A link is created to original document located at the destination location of the electronic message (Fig. 7, step 81 and paragraph [0032]). The last step stores the received electronic mail message without the attachment document (Fig. 7, step 82 and paragraph [0032]).

Claim 15 A computer program product in a computer readable storage medium for notifying a recipient of an electronic message of message reply requirements comprising having instructions determining whether a received electronic mail message at a destination location has a document attached to it (Fig. 4, step 48 and paragraph [0028]). When the electronic message does have an attached document there are instructions for determining whether the attachment was created at the location of the sender of the electronic message (Fig. 4, step 49 and paragraph [0028]). Next, when the determination is that the attachment did come from the sender location, there are instructions that delete the attached document from the electronic message (Fig. 7, step 76 and paragraph [0032]). After the deletion of the attached document, instructions create a link to the location of the original document at the destination location (Fig. 4, step 50 and paragraph [0028]). When there is a determination that the attachment document was originally created at the location of the sender of the electronic mail message, there are instructions for deleting the attachment document (Fig. 4, step 51 and paragraph [0028]). When an attachment is deleted, instructions update the received message to reflect the deleted attachment (Fig. 6, step 70 and paragraph [0031]). In the last step instructions determine if there are additional attached documents in the received electronic mail message (Fig. 6, step 72 and paragraph [0031]).

Claim 21 describes a method for managing attachments documents to electronic mail messages managing attachments documents to electronic mail messages having instructions for receiving an electronic mail message at a destination location (Fig. 7, step 73 and paragraph [0032]). Next there are instructions for determining whether a received electronic mail message at a destination location has a document attached to it (Fig. 7, step 74 and paragraph [0032]). When the determination is that the received electronic mail message does have the attachment document, instructions determine whether the attachment was locally created (Fig. 7, step 76 and paragraph [0032]). When the determination is that the attachment document was locally created, instructions determine whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message (Fig. 7, step 78 and paragraph [0032]). When the determination is that the user does not want to modify the attachment document, instructions delete the attachment document from the message (Fig. 7, step 79 and paragraph [0032]). A link is created to original document located at the destination location of the electronic message (Fig. 7, step 81 and paragraph [0032]). The last step stores the received electronic mail message without the attachment document (Fig. 7, step 82 and paragraph [0032]).

**6. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL**

**6.A. – Was 35 U.S.C. § 102(e) properly applied against claims 1-4, 7 and 15 through 20 as being anticipated by Malik (US patent 7,003,551)?**

**6.B. – Was 35 U.S.C. § 103(a) properly applied against claims 8, 10, 12-14 and 21-27 as being unpatentable over Malik in view of Dunn, U.S. Patent Application publication (2004/0034688).**

**7 ARGUMENTS IN SUPPORT OF SEPARATE PATENTABILITY**

7a. Arguments in response to 6a.

Initial review of the present invention

Applicants' present invention introduces unique functionality whereby there is a substantial reduction in the storage and replication requirements for the locally initiated electronic mail messages, which include locally sourced attachments. In the method of the present invention, at the origination location of an electronic message, there is an identification of electronic messages containing locally sourced attachment documents. During the storage of the transmitted message, there is determination of whether any attachment to the message was a locally sourced attachment. If the attachment was a locally sourced attachment, the attachment may not be stored with the message. Instead a pointer or link can be created to the original or locally sourced document. This approach will reduce the storage space required by electronic messages.

Initial review of the teachings of Malik

Malik provides an e-mail communications system that minimizes the number of duplicate copies of common attachment files to e-mail communications that are stored in the mail store of an e-mail server. When the e-mail server receives an e-mail attachment file that is larger than a threshold size, the server performs a database search for another copy of the attachment file in the mail store. If another copy is located, the system creates a pointer in the mail store that associates the located attachment file with the e-mail for

the additional recipient(s). Attachment files are deleted only after the recipients of the associated e-mail communications delete each of the respective e-mails.

Contrasting Malik with the present invention

Malik appears to be implemented in a configuration that has multiple users and a common store space for email attachments from the multiple users (mail store). The present invention is implemented in a configuration in which the users have individual storage locations for their attachments. With a multiple user storage configuration, Malik cannot specifically identify the sender of a message that has an attachment that came from the common storage location. With distinct storage location for individual users, the origin of an attachment can be determined in accordance with the present invention.

Applicant's invention includes the limitation of determining an origin of the attachment document to the electronic message, by determining whether the attachment document was created at the location of the sender of the electronic message. Malik does not perform this step. Malik can identify an attachment file from a storage location. However, Malik cannot determine if the attachment was originated at the sender location. For example, if the sender is forwarding a message with an attachment, the sender did not originate that attachment. The present invention would determine that the sender originated the attachment. In that case, the method of the present invention would not be necessary because there is no duplication in storing an attachment document.

In addition, the present invention includes a step that determines if multiple documents are attached to one email message. It is common for a user to attach more than one document to an email message. Contrary to the examiner's assertions, Malik does not teach or anticipate the attachment of multiple documents to an electronic mail message.

In order to sustain a novelty rejection each element of the claim has to be described by the cited reference. In this invention, the step of determining an origin of the attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message and the step of determining



if there are additional attachment documents in the received electronic mail message are not therefore the rejection should be withdrawn.

7b. Arguments in response to 6b.

The examiner states that Malik does not explicitly indicate when the determination is that the attachment document was locally created, determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message. Examiner further asserts that Dunn discloses when a user desires to modify an attachment a local copy of the document is obtained by the user. First, contrary to the Examiner's assertion, Dunn does not inquire whether a user desires to modify an attachment. In Dunn, the method responds to a modification of the attachment but there is no initial query of the user as described and claimed in the present invention. Second, Dunn obtains a local copy of the attachment to modify. In the present invention, the actual attached document is modified as indicated in Figure 7, steps 78 through 84. Therefore, Applicants submit that the step of determining whether the user desires to modify an attachment is not taught or suggested in Dunn. In addition, with the implementation of the query for modifying the attachment, the present invention automatically deletes the attachment if the determination that there is no desire to modify the attachment. This deletion step is necessary because of the modification query step.

**8. CONCLUSION**

In view of the above arguments, it is respectfully urged that the novelty rejection of the claims should not be sustained. Although the cited references do have similarities to Applicants' present invention, Applicants submit Malik does not describe the present invention as claimed. Applicants submit that not all of the features of the present invention are described in Malik. Applicants assert that the examiner is incorrect in asserting that some of the features of the Applicants' present invention are inherent in Malik.

In view of the above arguments, it is respectfully urged that the obviousness rejection of the claims should not be sustained. Although the cited references do have similarities none of the art of record (alone or in combination) teaches, discloses or even suggests the invention as recited in each of Applicant's claims. In particular none the cited references teach, or suggest the step of "identifying an appropriate communication protocol conversion routine, when the determination is that the communication protocol formats are not compatible". Therefore, Applicants submit that all of the pending claims are in condition for allowance. Withdrawal of the rejections and passage to issuance is respectfully requested.

In view of the above, Applicant respectfully submits  
Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance.

Respectfully Submitted,  
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March 23, 2009

## APPENDIX I - CLAIMS

Claim 1 (Previously presented) A method for managing attachments documents to electronic mail messages comprising the steps of;

receiving an electronic mail message at a destination location;

determining whether there is an attachment document associated with the received electronic mail message;

when the determination is that there is an attachment document, determining an origin of the attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message;

when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message, deleting the attachment document from the electronic mail message received at the sender location of the electronic mail message originated at the destination location of the electronic message;

creating a link to the original document located at the destination location of the electronic message;

deleting the attachment document when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message

updating the received message to reflect the deleted attachment; and

determining if there are additional attachments documents in the received electronic mail message.

Claim 2 (Original) The method as described in claim 1 wherein the destination location of the electronic message is the location of the sender of the electronic message.

Claim 3 (Original) The method as described in claim 1 further comprising before said origin determination step the step of determining whether the received electronic message has an attachment.

Claim 4 (Original) The method as described in claim 1 further comprising after ~~said~~ the attachment deleting step, the step of saving the electronic message.

Claim 5 (Canceled)

Claim 6 (Canceled)

Claim 7 (Original) The method as described in claim 1 further comprising before said attachment origin determination step, the step of determining whether the recipient of an electronic message desires to save the electronic message.

Claim 8 (Previously presented) A method for managing attachments documents to electronic mail messages comprising the steps of;

- receiving an electronic mail message at a destination location;

- determining whether a received electronic mail message has an attachment document;

- when the determination is that the received electronic mail message does have the attachment document, determining whether the attachment was locally created;

- when the determination is that the attachment document was locally created, determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message;

- when the determination is that the user does not want to modify the attachment document, deleting the attachment document from the message;

- creating a link to the original document located at the destination location of the electronic message; and

- storing the receive electronic mail message without the attachment document.

Claim 9 (Canceled)

Claim 10 (Original) The method as described in claim 8 further comprising before said origin determination step the step of determining whether the received electronic message has an attachment.

Claim 11 (Canceled)

Claim 12 (Original) The method as described in claim 8 wherein said attachment origin determination step further comprises determining whether the attachment was created at the location of the sender of the electronic message.

Claim 13 (Original) The method as described in claim 8 further comprising before said link creation step, the step of updating the received message to reflect the modified attachment.

Claim 14 (Original) The method as described in claim 8 further comprising before said attachment origin determination step, the step of determining whether the recipient of an electronic message desires to save the electronic message.

Claim 15 (Previously presented) A computer program product in a computer readable storage medium for notifying a recipient of an electronic message of message reply requirements comprising:

- instructions receiving an electronic mail message at a destination location;

- instructions determining whether there is an attachment document associated with the received electronic mail message;

- when the determination is that there is an attachment document, instructions determining an origin of an attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message;

- when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message, instructions deleting the attachment document from the electronic mail message received at the sender location of the electronic mail message originated at the destination location of the electronic message;

- instructions creating a link to an original document located at the destination location of the electronic message;

instructions deleting the attachment document when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message

instructions updating the received message to reflect the deleted attachment; and

instructions determining if there are additional attachment documents in the received electronic mail message.

Claim 16 (Original) The computer program product as described in claim 15 further comprising before said origin determination instructions, instructions for determining whether the received electronic message has an attachment.

Claim 17 (Original) The computer program product as described in claim 15 further comprising after said attachment deleting instructions, instructions for saving the electronic message.

Claim 18 (Original) The computer program product as described in claim 15 wherein said attachment origin determination instructions further comprise instructions for determining whether the attachment was created at the location of the sender of the electronic message.

Claim 19 (Original) The computer program product as described in claim 15 further comprising before said link creation instructions, instructions for updating the received message to reflect the deleted attachment.

Claim 20 (Original) The computer program product as described in claim 15 further comprising before said attachment origin determination instructions, instructions for determining whether the recipient of an electronic message desires to save the electronic message.

Claim 21 (Previously presented) A computer program product in a computer readable storage medium for managing attachments documents to electronic mail messages comprising:

instructions receiving an electronic mail message at a destination location;

instructions determining whether a received electronic mail message has an attachment document;

when the determination is that the received electronic mail message does have an attachment document, instructions determining whether the attachment was locally created;

when the determination is that the attachment document was locally created, instructions determining whether the electronic mail recipient desires to modify the attachment document that was locally created at the destination location of the electronic message;

when the determination is that the user does not want to modify the attachment document, instructions deleting the attachment document from the message;

instructions creating a link to the original document located at the destination location of the electronic message; and

instructions storing the receive electronic mail message without the attachment document.

Claim 22 (Original) The computer program product as described in claim 21 further comprising after said modification determination instructions, instructions for modifying the attachment.

Claim 23 (Original) The computer program product as described in claim 21 further comprising before said origin determination instructions, instructions for determining whether the received electronic message has an attachment.

Claim 24 (Original) The computer program product as described in claim 22 further comprising after said modification determination instructions, instructions for deleting the attachment when there is a determination that the recipient does not want to modify the attachment.

Claim 25 (Original) The computer program product as described in claim 21 wherein said attachment origin determination instructions further comprise instructions for determining whether the attachment was created at the location of the sender of the electronic message.

Claim 26 (Original) The computer program product as described in claim 21 further comprising before said link creation instructions, instructions for updating the received message to reflect the modified attachment.

Claim 27 (Original) The computer program product as described in claim 21 further comprising before said attachment origin determination instructions, instructions for determining whether the recipient of an electronic message desires to save the electronic message.



## **EVIDENCE APPENDIX**

In accordance with 37 CFR 41.37, submitted herein evidence entered by the examiner and relied upon by appellant in the appeal. The examiner in an office letter dated August 14, 2008 entered the evidence. The evidence includes:

United States Patent Number 7,003,551 – Malik

United States Patent Application Publication Number 20040034688 - Dunn

# **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings for this appeal.